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Docket No: TPI-T600XC1
Serial No: 09/994,585Remarks

Claims 1, 15, 51, 66, 81-105, and 107-150 are pending in the subject application. Applicant acknowledges that claims 1, 15, 51, 66, 132-141 and 143-149 have been withdrawn from further consideration as being drawn to a non-elected invention. By this Amendment, Applicant has canceled claim 106 and amended claims 81 and 110. Support for the amended claims can be found throughout the subject specification and in previously pending claim 106. Applicant respectfully submits that the amended claims should not require a new search or consideration of new issues as claim 81 has been amended to read on the elected species of calcium oxalate as the elected invention and claim 110 has been amended to correct the dependency of the claim in view of the cancellation of claim 106. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 81-105, 107-131, 142 and 150 are currently before the Examiner and read on the elected invention. Favorable consideration of the pending claims is respectfully requested.

Claims 81-131, 142 and 150 are rejected under 35 U.S.C. §102(e) as being anticipated by Levinson *et al.* (WO 01/51919). Applicant respectfully submits that the cited reference fails to anticipate the claimed invention as it fails to teach a "disease causing substance comprising calcium oxalate". Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

Claims 81-131, 142 and 150 are rejected under 35 U.S.C. §103(a) as being unpatentable over Selengut *et al.* (U.S. Patent No. 5,776,348) in view of Klein *et al.* (Klein, J. *et al. Angew. Chem. Int. Ed.* 1998, 37(24), 3369-3372), Jandeleit *et al.* (Jandeleit, B. *et al. Angew. Chem. Int. Ed.* 1999, 38, 2494-2532), Embiata *et al.* (Embiata-Smith, D.F. *et al. Organic Res. & Develop.* 1999, 3, 281-288), and Findlay *et al.* (Findlay, W.P. *et al. J. Pharm. and Biomed. Anal.* 1998, 16, 921-930). Applicant traverses.

Applicant respectfully submits that the combination of references fails to establish a *prima facie* case of obviousness for the claimed invention. Particularly, the combination of references fails to teach dispensing calcium oxalate in liquid or dissolved form and one or more additional components into sample tubes or sample wells with an automated distribution mechanism. As the Patent Office is aware, each and every limitation of the claimed invention must be taught or suggested by the prior art in order to establish a *prima facie* case of obviousness for a particular

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invention (*In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). Thus, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested as a *prima facie* case of obviousness has not been established for the claimed invention.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicant's agreement with or acquiescence in the Examiner's position. Applicant expressly reserves the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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